

REMARKS

Upon entry of the present amendment, the claims in the present application will not have been amended to improve clarity but do not narrow the scope thereof. Applicants respectfully request reconsideration and withdrawal of the outstanding rejections set forth in the abovementioned Official Action.

Initially, Applicants wish to respectfully thank the Examiner for considering the Information Disclosure Statements filed in the present application on February 15, 2006; September 1, 2004; June 23, 2004; April 22, 2005 and June 7, 2005, by the return of the signed and initialed PTO-1449 Forms attached to each of these Information Disclosure Statements.

Moreover, Applicants note that the present application claims the effective filing date of Japanese Application No. 8-082296 filed on April 14, 1996. Accordingly, Applicants respectfully request that the Examiner clarify the record by explicitly confirming Applicants' claim for foreign priority under 35 U.S.C. § 119 and acknowledging that the certified copy of the foreign priority document has been received in the parent application. Such action is respectfully requested and is now believed to be appropriate and proper.

In the outstanding Official Action, the Examiner rejected claims 1-11 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-11 of prior U.S. Patent No. 6,876,462. The Examiner noted that this is a double-patent rejection and that it cannot be overcome by the filing of a Terminal Disclaimer. Applicants respectfully traverse the above rejection and submit that it is inappropriate and should thus be withdrawn, and the claims in the present application should be allowed to issue, in due course.

Initially Applicants note that claims 1-10 have been cancelled in the present application by the Preliminary Amendment filed on July 13, 2005. Claims 11-21 are pending. It is assumed

that the Examiner intended to reject the pending claims and the rejection will thus be treated as directed to the pending claims.

As set forth by the Examiner in the Official Action, in the context of a double-patenting rejection, the term “same invention” means an invention drawn “identical subject matter”. Mill re: Vogel, 422F.2d 438, 164 USPQ 619 (CCPA 1970). As can be seen by a comparison of the terminology of the patented claims and the claims pending in the present application, they do not define identical subject matter.

As additionally pointed out by the Examiner, a double-patent rejection under 35 U.S.C. § 101 can be overcome by amending the conflicting claims so that they are no longer coextensive in scope. Applicant respectfully submits that since the claims in the present application are not coextensive in scope with the claims of the patent, there is no need to amend the claims but that the Examiner’s statutory type double-patenting rejection is inappropriate and should thus be withdrawn.

In particular, Applicant’s claim 1 recites, *inter alia*, a receiver that receives e-mail data “from a sender”. In contrast, claim 1 of the patent recites a receiver that receives the e-mail data “from a requesting node”. Clearly, a sender is not a requesting node and a requesting node is not a sender. These differing terms thus clearly indicate that the claims of the patent and the claims of the present application are not drawn to the same invention as they are not drawn to identical subject matter.

A requesting node does not necessarily have to be a sender and a sender does not necessarily have to be a requesting node. Accordingly, the scope of these claims is clearly not coextensive and for this reason alone, the Examiner’s 35 U.S.C. § 101 double-patenting rejection is submitted to be deficient.

Moreover, Applicants note that each of the independent claims of the present application recites a sender while each of the independent claims of the patent recites a requesting node, in the appropriate context. Accordingly, the Examiner's statutory double-patenting rejection is inapplicable to any of the claims in the present application because they are not for the same invention and are not drawn to identical subject matter as the corresponding claims in the patent. For this reason alone, it is respectfully submitted that the Examiner's rejection is inappropriate and should be reconsidered and withdrawn.

Moreover, Applicants respectfully submit that even if the Examiner were to assert a non-statutory (obviousness type) judicially created double-patenting rejection, such a rejection would be inappropriate in the present situation. In this regard, there is no evidence of record to motivate one of ordinary skill in the art to utilize, in the claimed combinations, a receiver that receives e-mail from a sender as opposed to receiving e-mail data from a requesting node. Without such motivation or teaching, an obviousness type double-patenting rejection would also not be appropriate or proper in the present application.

In addition to the above-noted difference in scope between the claims of the present application and the claims of the parent application, Applicant additionally notes that, taking claim 11 as an example, a memory is recited that is configured to store a password and a domain name. In direct contrast, the memory of the patent is recited to store a password and a domain name of a requesting node. Similarly, claim 11 of the present application recites an acquirer configured to acquire a password and a sender domain name from the sender, the sender domain name being included in the sender address. In direct contrast, the acquiring section recited in claim 1 of the patent acquires a destination address including at least a telephone, a password and a domain name from the requesting node. Each of the above-noted differences in language of

the claims results in claims that are not drawn to identical subject matter and to claims that are not coextensive in scope. Accordingly, for each of the above-noted additional reasons, it is respectfully submitted that Applicants' claims are not properly subject to a double-patenting rejection based on the same invention.

While the above-noted remarks were directed primarily to a comparison of the language of claim 11 of the application to claim 1 of the patent, at least similar arguments with respect to the sender of the present application and the requesting node of the patent are applicable for all of the independent claims. Accordingly, at least for the above-noted reasons, the Examiner's rejection is submitted to be inappropriate and should be reconsidered and withdrawn.

Moreover, as noted above, Applicants respectfully submit that there is no proper basis for an obviousness type double-patenting rejection between the language of the claims in the present application and the language of the claims of the patent.

Additionally, Applicants note that they have, by the present response, further revised the language of the claims. These amendments are not made in view of the prior art and do not constitute a narrowing of the scope of the claims in any fashion. Rather, these amendments are made so as to improve the format, clarity and readability of the claim language. Thus, no prosecution history estoppel should attach to these changes.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection together with an indication of the allowability of all the claims in the present application, particularly in view of the fact that the only outstanding rejection has been traversed and that no prior art has been cited against the claims in the present application.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have not amended the claims in any significant fashion. Rather, Applicants have traversed the Examiner's rejection and pointed out the shortcomings and deficiencies thereof. Applicants have amended the claims for clarity and to improve the idiom, syntax and grammar thereof. Accordingly, Applicants submit that they have provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully request an indication to such effect, in due course.

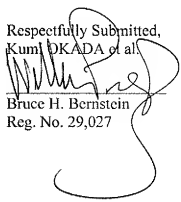
Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should an extension of time be necessary to maintain the pendency of this application, including any extensions of time required to place the application in condition for allowance by an Examiner's Amendment, the Commissioner is hereby authorized to charge any additional fee to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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